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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/011,940	03/03/1999	MICHAEL A. NAUCK	864861USWO	1535

7590 05/30/2003

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EXAMINER

CELSA, BENNETT M

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 05/30/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

Office Action Summary

Application No.
09/011,940

Applicant(s)
Nauck et al.

Examiner
Bennett Celsa

Art Unit
1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 6, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 17-19, 21, 23-26, 28-39, and 41-51 is/are pending in the application.
- 4a) Of the above, claim(s) 26, 28-31, and 36-39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 46 is/are allowed.
- 6) ☒ Claim(s) 1, 17-19, 21, 23-25, 32-35, 41-45, and 47-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/6/03 has been entered.
2. **NOTE:** the location of the present application is **ART UNIT 1639**.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of the Claims

Claims 1, 17-19, 21, 23-26, 28-39 and 41-51 are currently pending.

Claims 26, 28-31 and 36-39 are withdrawn from consideration as being directed to a nonelected invention.

Claims 1, 17-19, 21, 23-25, 32-35 and 41-51 are currently under consideration.

Election/Restriction

Applicant's election with traverse of Group I (claims 1-2 and 17-25) and the species GLP-1 and glucose in Paper No. 12 is again acknowledged.

Claims 26, 28-31 and 36-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

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Withdrawn Objection (s) and/or Rejection (s)

Applicant's amendment and argument has overcome the indefinite rejection of claims 20, 41 and 44 in the final office action (paper no. 21)..

Applicant's amendment and argument has overcome the rejection of claim 21 (and claims dependent thereon) under 35 U.S.C. 112, first paragraph, for new matter concerning the new limitation of claim 21, e.g. "are administered at a rate of 0.01 ... per minute"

Applicant's amendment and arguments have overcome the anticipation rejection over Habener, U.S. Pat. No 5,614,492 (3/97: filed 9/91 or earlier).

Applicant's amendment and arguments have overcome the obviousness rejection over the Specification disclosure as to the state of the prior art in view of Habener, U.S. Pat. No. 5,614,492 (3/97: filed 9/91 or earlier) and/or Eng US Pat. No. 5,424,286 (6/95) .

New Objection (s) and/or Rejection (s)

Claim Objections

4. Claims 17-18 and 47 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 17 and 18 are 47 dependent upon canceled claim 2. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form (e.g. to depend on claim 1), or rewrite the claim(s) in independent form. .

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Claim Rejections - 35 USC § 112

5. Claims 1, 17-19, 21, 23-26, 28-39, 41, 43-45 and 47-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 17, 18 and 47 lack antecedent basis since these claims are dependent upon canceled claim 2. Amending to depend on claim 1 will overcome this rejection.

B. In claim 1, 41, 44 (and claims dependent thereon) , the term “D-terminus ketones thereof” is not understood. What is the “D-terminus” Amending to assert -- C-terminus” as supported on bottom of specification page 8 will overcome this rejection.

6. Claim 42 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (NEW MATTER REJECTION).

In claim 42, although the specification provides support enhancing metabolism of nutrients in patients “with a disturbed glucose metabolism, a surgery patient, a comatose patients, a patient in shock” the specification and original claims fails to provide support for the remaining diseases/disorders e.g. “with a gastrointestinal disease chronic pancreatitis”

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Allowable Subject Matter

7. Claim 46 is allowable over the prior art of record.
8. Claims 1, 17-19, 21, 23-25, 32-35, 41-45 and 47-51 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

General information regarding further correspondence

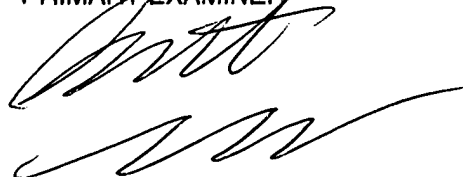
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)
May 29, 2003

BENNETT CELSA
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'Bennett Celsa', written over the printed name and title.